REMARKS

Claims 8-16 are pending in this application. After claim amendments, cancellations and additions herein, claims 9, 11-13 and 19-22 will remain pending in this application.

In the Office Action dated June 14, 2006, the Examiner acknowledged the election without traverse of Group II, claims 8-16 drawn the special technical feature of an antibody product against a C-terminal peptide of GPC 3, and the cancellation of claims 1-7, 17 and 18. The Examiner also objected to a misspelled word at page 7, line 24 of the specification, and Applicants have herein corrected this error.

The Examiner rejected claims 9 and 10 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. The Examiner states that amino acid residues 359-380 and 375-580 named in these claims are not identified by SEQ ID NOS. In response, Applicants have amended claim 9 to recite the SEQ ID NO. of the identified amino acid residues and have canceled claim 10, thereby overcoming this rejection.

The Examiner also rejected claim 12 as being indefinite because it recites the word "chimera", which the Examiner states is not defined in the specification. Applicants traverse this rejection. Applicants point out to the Examiner that the definition of the term "chimera antibody" is specifically described in the specification at page 19, lines 3-9, and those skilled in the art can easily understand the structure of the chimeric antibody from the disclosure of the specification. Also, Applicants herewith submit a copy of several pages from a common textbook published before the priority date of this application, which explicitly sets forth the meaning of the term "chimeric antibody" (see *Clinical Aspects of Immunology*, Blackwell Scientific Publications 5th Edition, 1993, pp. 823-24). This textbook demonstrates that those skilled in the art could recognize the meaning of the term as of the priority date of the present application. Accordingly, Applicants request that the Examiner withdraw this rejection.

The Examiner also rejected claims 9 and 10 under 35 U.S.C. § 112, first paragraph, because, according to the Examiner, the specification is enabled for antibodies against the C-terminal peptide of GPC3 but not for the antibodies when the C-terminal peptide of GPC3 is a peptide comprising amino acid residues 359-380 and 375-580 of GPC3. In response, Applicants have canceled claim 10 and have amended claim 9 to specify the antigen bound by the antibody of the invention with the language "consisting of". Applicants assert that claim 9 is now fully enabled and respectfully request that this rejection be withdrawn.

Claims 9 and 10 were further rejected as lacking an adequate written description of the invention, because, according to the Examiner, the specification does not provide the complete structure of any protein comprising the C-terminal peptide of GPC3 wherein the C-terminal peptide of GPC3 is a peptide comprising amino acid residues 359-380 and 375-580 of GPC3. Applicants point out to the Examiner that claim 10 has been canceled and that claim 9 has been amended to specify the antigen bound by the antibody of the invention with the language "consisting of". Applicants assert that claim 9 now contains a full written description and respectfully request that this rejection be withdrawn.

The Examiner rejected claims 13-16 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement because, according to the Examiner, the specification is enabled for cytotoxic, anti-cancer agent comprising an antibody to SEQ ID NO: 4 amino acid residues 359-380 and 375-580 but not for cytotoxic, anti-cancer agent to the C-terminal peptide of GPC3. In response, Applicants note that claims 14-16 have been canceled and that claim 13 now depends from claim 9, which satisfies the enablement requirement due to the use of the language "consisting of", as set forth above. Applicants now request that this rejection be withdrawn.

The Examiner also rejected claims 8-11 and 13-16 under 35 U.S.C. § 101 because the claims are directed to nonstatutory subject matter. According to the Examiner, the antibody as claimed has the same characteristics as antibodies found naturally, and the claims do not sufficiently distinguish over antibodies that exist naturally. Applicants thank the Examiner for helpfully advising that addition of the word "isolated" would overcome this rejection, and

Applicants point out that they have canceled claims 8, 10 and 14-16 and have so amended claim 9, from which claims 11 and 13 now depend. Applicants now request that the rejection of claims 9, 11 and 13 be withdrawn.

The Examiner also rejected claims 8, 11 and 14-16 under 35 U.S.C. § 102(b) as being anticipated by Capurro et al. (March 2002), which the Examiner states teaches a monoclonal antibody to the C-terminus of GPC3 and all the limitations of these claims. Applicants traverse this rejection. The Examiner also rejected claims 8 and 13-16 under 35 U.S.C. § 102(b) as being anticipated by Huber (December 1998), which the Examiner states teaches all the limitations of these claims. In response to these rejections, Applicants have canceled claims 8 and 14-16 and have amended claim 9, from which claims 11 and 13 now depend, to recite "An isolated antibody against a C-terminal peptide of GPC 3, wherein the C-terminal peptide of GPC 3 is a peptide consisting of amino acid residues 359-580 of GPC 3 or a peptide consisting of amino acid residues 375-580 of GPC 3, as set forth in SEQ ID NO: 4." In amended claim 9, the antigen epitopes of the anti-GPC3 antibody are clearly specified, and the claimed invention as amended is patentably distinguishable from the invention disclosed in either Capurro et al. or Huber, wherein the structure of the antibody is not specifically disclosed. Accordingly, the rejections of claims 11 and 13 should be withdrawn.

The Examiner also rejected claims 8 and 11-16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0236080 (Aburatani et al.). Applicants thank the Examiner for helpfully pointing out that this rejection may be overcome by a showing that any invention disclosed but not claimed in that reference was derived from the inventor of this application. Indeed, Applicants respectfully traverse this rejection and point out that U.S. Patent Application Publication No. 2004/0236080 (Aburatani et al.) is not available for use as prior art against the instant application under 35 U.S.C. § 102(e) because the disclosures thereof are not an invention by "another". As set forth in the accompanying Declaration of Inventor Iwao Ohizumi Under 37 C.F.R. § 1.132, Applicants establish that the portions of U.S. Patent Application Publication No. 2004/0236080 (Aburatani et al.) that are relied upon by the Examiner in this rejection of claims 8 and 11-16 under 35 U.S.C. § 102(e) is subject matter that was invented by Iwao Ohizumi, an inventor of the present invention, notwithstanding the

inventorship listed on the face of the reference. See M.P.E.P. §§ 706.02(b), 715.01(c) and 716.10. Because of this fact, U.S. Patent Application Publication No. 2004/0236080 (Aburatani et al.) is not available for use against the present application under 35 U.S.C. § 102(e), and Applicants respectfully request that this rejection be withdrawn.

The Examiner further rejected claim 12 under 35 U.S.C. § 103(a), as being unpatentable over Capurro et al. (March 2002), in view of Queen et al. (1989) and Riechmann et al. (1988). Applicants traverse this rejection. As discussed above, Applicants amended claim 9, from which claim 12 now depends, to recite "An isolated antibody against a C-terminal peptide of GPC 3, wherein the C-terminal peptide of GPC 3 is a peptide consisting of amino acid residues 359-580 of GPC 3 or a peptide consisting of amino acid residues 375-580 of GPC 3, as set forth in SEQ ID NO: 4." In amended claim 9, the antibody of the invention is specified by the structure of the antigen, and the claimed invention as amended is patentably distinguishable from the invention disclosed in either Capurro et al., wherein the structure of the antibody is not specifically disclosed. In addition, neither Queen et al. nor Riechmann et al. disclose this. Accordingly, Applicants respectfully request that the rejection of claim 12 be withdrawn.

Finally, the Examiner rejected claims 8-16 under 35 U.S.C. § 101 as claiming the same invention as that of claims 8-18 of co-pending U.S. Patent Application No. 11/414,676. However, Applicants point out to the Examiner that co-pending U.S. Patent Application No. 11/414,676, filed April 28, 2006, is a divisional of the present application and that claims 8-18 thereof were canceled upon filing of that application. This is clearly set forth on page 3 of the Preliminary Amendment dated April 28, 2006 that was filed with U.S. Patent Application No. 11/414,676. Accordingly, this rejection should be withdrawn.

Applicants note that new claims 19-22 have been added to this application. These claims depend from either claim 9 or claim 13, which themselves are allowable, such that new claims 19-22 are also allowable.

Conclusion

Reconsideration of the present application, as amended, is respectfully requested. If the Examiner has any questions or concerns regarding this response and amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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